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IN THE

Supreme Court of the United States

OCTOBER TERM, 1942

No. 509

Can this be folded some way?

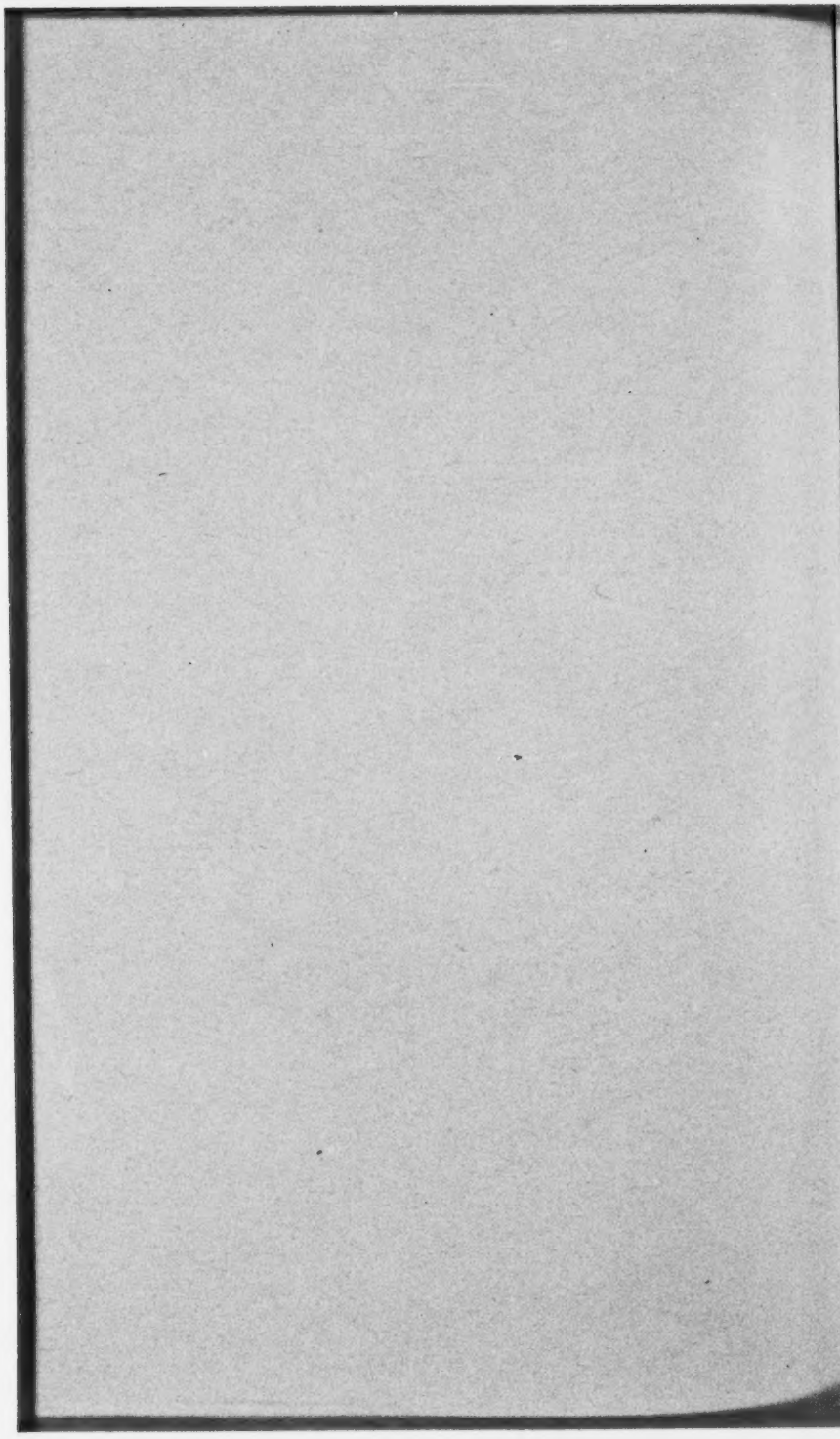
GEORGE VAN WORMER,
Petitioner,

vs.

THE CHAMPION PAPER & FIBRE COMPANY,
Respondent.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES CIRCUIT COURT OF APPEALS, SIXTH CIRCUIT AND BRIEF IN SUPPORT THEREOF.

WALTER F. MURRAY,
MURRAY, SACKHOFF & PADDACK,
First National Bank Bldg.,
Cincinnati, Ohio,
Counsel for Petitioner.



IN THE

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GEORGE VAN WORMER,
Petitioner,

vs.

THE CHAMPION PAPER & FIBRE COMPANY,
Respondent.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES CIRCUIT COURT OF APPEALS, SIXTH CIRCUIT

To the Honorable the Chief Justice and Associate Justices of the Supreme Court of the United States:

Your petitioner, George Van Wormer, respectfully prays for a writ of certiorari to review a decision and decree of the United States Circuit Court of Appeals for the Sixth Circuit in the above cause, rendered and entered on June 29, 1942, and therefore shows as follows:

SUMMARY STATEMENT OF THE MATTER INVOLVED

Petitioner sued the respondent for infringement of his Patent No. 1,947,748, hereafter referred to as the Van Wormer patent. This patent was for a machine for cleaning the surface of fine paper stock of fibers that had been indented into the paper, and would form white spots in prints by becoming interposed between the paper and the printing press.

The Van Wormer patent described the means for removing the fibers from the paper, as a series of hog-bristle brushes rotated in the direction in which the paper moved through the casing. Claim 1 before the disclaimer, had as an element the following: "paper brushing devices therein arranged and including exceedingly attenuated and flexible paper surface engaging members to engage a moving sheet in the casing".

A need for a disclaimer was made by respondent's setting up the Wood patent in its amendment to its answer. (Rec. page 13). This Wood Patent No. 1,089,453, (Rec. II, page 116), illustrated and described a device that cleaned paper by a pair of rotating brushes made of camel's hair, and rotated in a direction opposite to the movement of the paper.

On September 26, 1938, your petitioner filed the following disclaimer:

> "Hereby enters this disclaimer to the part of claim 1 and claim 2 that relates to the paper brushing devices arranged to engage a moving sheet, except where the brushes are made of a fairly heavy hog bristle and are arranged to rotate in the direction in which the sheet is moving; and that part of claim 3 that relates to rotary brushes except where they are made of a fairly heavy hog bristle."

The District Court found that the disclaimer was invalid. The Court of Appeals of the Sixth Circuit affirmed this finding, saying:

> "We think that appellee's contention that the disclaimer introduced a new element into the claim and hence invalidates it must be sustained. The limitation in the disclaimer to the use of a brush composed of hog bristles does not extend the claim. It originally specified paper brushing devices, and such devices might be either of camel's hair or bristles, or any proper brush material. However, the claim as originally written does not include the rotation of the brushes. It is quite conceivable that under the broad phrase 'paper brushing devices therein arranged' the brushes might be vibrated instead of rotated. Appellee urges, and it is true, that the specifications described rotation of the brushes, but that does not save the claim which is so broadly drawn as not to include this element." Citing *Altoona Publix Theatres, Inc.* v. *American Tri-Ergon Corp.*, 294 U. S. 477 and *Milcor Steel Company* v. *George A. Fuller Co.*, 62 Sup. Ct. 969, 86 Law Ed. 897.

The decision of the Circuit Court of Appeals is reported at 129 Fed. Rep. 2(d) page 428. Petitioner in due time presented to the Circuit Court of Appeals his petition and brief for a rehearing, in which it was stated that; "The Court erred in finding that by the disclaimer the patentee introduced a new element into the claim." (Rec. page 281). The Circuit Court of Appeals denied the Petition for Rehearing on August 28, 1942. (Rec. page 285).

REASONS RELIED UPON FOR GRANTING CERTIORARI

Petitioner is advised, and therefore alleges, that the Decree of the Circuit Court of Appeals in this case shows that there is urgent need for this Court's clarifying what constitutes the addition of a new element to a combina-

tion claim in a patent, in *Altoona Publix Theatres, Inc.* v. *American Tri-Ergon Corp.*, 294 U. S. 477, and *Milcor Steel Company* v. *George A. Fuller Co.*, 314 U. S. 604.

In the instant case the Court of Appeals, after discussing the Altoona Publix Theatres, Inc. case and the Milcor Steel Company v. George A. Fuller case, said: "This holding compels the conclusion that the addition of the element of rotation of the brushes in the same direction of travel as the paper passing through the machine, which appellant insists is an essential part of the invention, introduces an element not present in the original claim, and thus invalidates both the disclaimer and the claim itself." (Rec. page 278).

IN THE

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OCTOBER TERM, 1942

GEORGE VAN WORMER,
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Respondent.

BRIEF IN SUPPORT OF ACCOMPANYING PETITION FOR WRIT OF CERTIORARI

The decision of the Circuit Court of Appeals is found on page 274 of the record and is printed at page 428 of 129 Fed. Rep. 2(d) series.

JURISDICTION

Jurisdiction is invoked under Section 347 in U. S. Code Title 28.

STATEMENT OF THE CASE AND QUESTIONS INVOLVED

The petition for writ of certiorari contains a statement of the questions involved in this case as well as of all the facts and material to be given consideration.

ARGUMENT

The question which Your Petitioner wishes to present is as to whether the disclaimer in this case comes under the interdict of this Court that the disclaimer statute does

not permit the addition of a new element to the combination previously claimed, as given in *Altoona Publix Theatres, Inc.* v. *American Tri-Ergon Corp.*, 294 U. S. 477, and *Milcor Steel Co.* v. *George A. Fuller Co.*, 314 U. S. 604. It is submitted that the decision of the Circuit Court of Appeals in this case demonstrates that there should be a clarification by this Court of what is meant by the addition of an element to the combination previously claimed, as used in the Altoona v. Tri-Ergon and Milcor v. Fuller cases, supra.

In the Altoona case the disclaimer was as follows: Disclaims "the combination as set forth in claim 13, except wherein a fly-wheel is operatively connected with the film through means which imparts uniformity of motion of the fly-wheel to the film". This Court said that this disclaimer "operated to add the fly-wheel as a new element" to claim 13. Claim 13 had as an element "means for imparting to the film a rapid and uniform motion". The means which the specification described for imparting uniform motion was a fly-wheel. Hence, as ordinarily understood in patent law, the original claim had a means for imparting uniformity of motion, in general terms. This disclaimer made this means specific.

In Milcor Steel Co. v. Fuller the disclaimers were to claims 6 and 7 of the patent. These claims related to a wall construction of a room. Both claims had as elements the following ones, viz: base members, ceiling members and wall supports connecting the base and the ceiling members. Claim 6 had another element, viz: "means operative to prevent any substantial tilting movement of said wall supports * * *". Claim 7 had in it this provision, "said base member and said ceiling member being shaped to provide means which are operative to prevent any sub-

stantial tilting of said wall supports * * *". The disclaimer to claim 6 limited the tilting preventing means to a ceiling member comprising a "vertical depending perforated flange, one side of which is overlapped by metal lath". The disclaimer to claim 7 limited the tilting preventing means to a base member "composed of a longitudinal strip having recesses to receive the lower ends of the webs of channel wall supports, the flanges of the channel wall supports overlapping the base member adjacent the recesses".

Therefore, in both the Altoona Publix Theatres and Milcor v. Fuller cases, the disclaimers limited the claims to specific tangible things that had been included in the combination claims broadly by the use of the word "means", i. e., in the Altoona Publix Theatres "means" for imparting uniform motion longitudinally of the film past said wheel, was limited by the disclaimer to a "flywheel", and in Milcor Steel Co. v. Fuller, the "means" operative to prevent tilting movement of the wall supports was limited by the disclaimer to claim 6 to a certain "depending perforated flange" overlapping the lath, and in claim 7 to a certain base member composed of a "longitudinal strip" having recesses to receive the lower end of the wall supports. *In the instant case the Court referred to something intangible as an added element*, by the words, "*the addition of the element of rotation of the brushes* in the same direction of travel as the paper * * * *introduces an element* not present in the original claim". *In Altoona Publix Theatres and in Milcor Steel, the disclaimers changed a tangible element, expressed in general terms as "means", to a specific tangible element. In the instant case, the Court referred to something intangible, viz: rotation of brushes as being an element that was added by the disclaimer.*

It is submitted that, in the Altoona and the Milcor cases, supra, it is difficult to understand the ruling that the changing of an element of a combination claim from general terms to specific terms constitutes the addition of an element thereto. It is incomprehensible in the instant case how the reference in the disclaimer to the rotation of the brushes, constituted the addition of an element to the claim. *It is respectfully submitted that what is meant by "the addition of an element to a claim" needs clarification by this Court.*

CONCLUSION

It is submitted that the question herein presented is important not merely to the parties involved, but is of general and vital interest, and that a writ of certiorari should be granted.

Respectfully submitted,

WALTER F. MURRAY,
Counsel for Petitioner.

Petitioner moves that the Petition be considered on 10 copies of Volume I and one copy of Volume II, of the Transcript of Record and that he be released from the requirement to reprint the latter. The ground for the motion is that he is in poor financial circumstances. (Rec. Vol. I, Page 56).

Respectfully,

WALTER F. MURRAY,
Counsel for Petitioner.

Feb. 20, 1934. G. VAN WORMER 1,947,748

PAPER CLEANING MACHINE

Filed Nov. 12, 1931 3 Sheets-Sheet 1

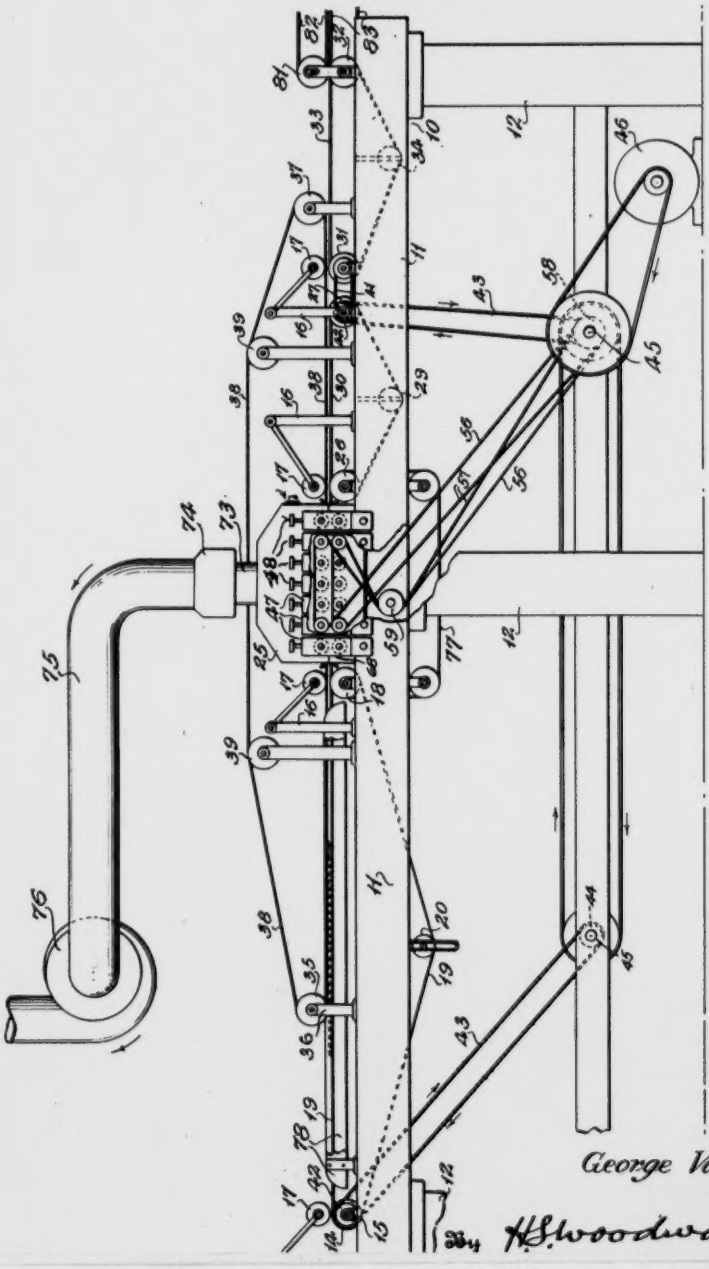


Fig. 1.

Inventor

George Van Worm

H. S. Woodward,

Feb. 20, 1934. G. VAN WORMER 1,947,748

PAPER CLEANING MACHINE

Filed Nov. 12, 1931 3 Sheets-Sheet 2

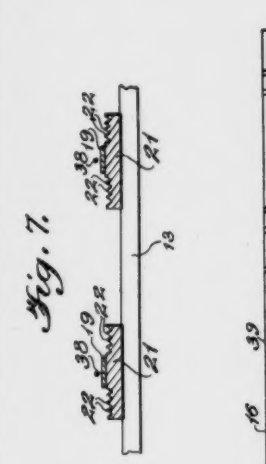


Fig. 7.

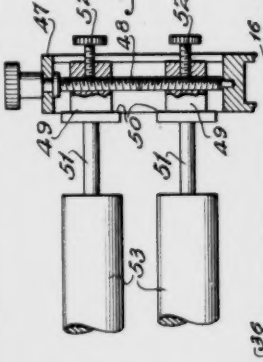


Fig. 6.

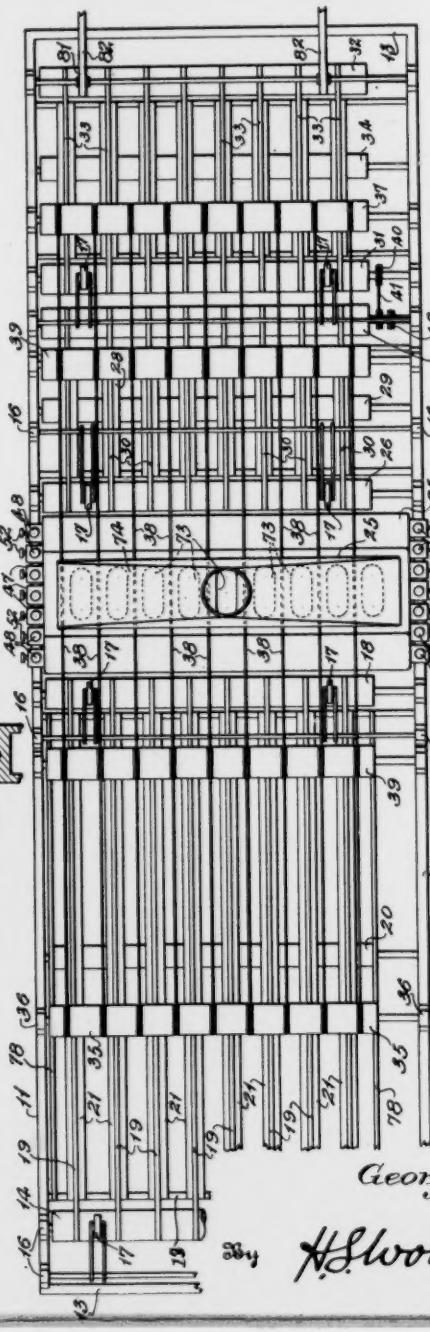


Fig. 2.

Inventor:
George Van Wormer
By H. S. Woodward
Attorney

Feb. 20, 1934. G. VAN WORMER 1,947,74

PAPER CLEANING MACHINE

Filed Nov. 12, 1931 3 Sheets-Sheet

Fig. 3.

Fig. 5.

Fig. 4.

George Van Wo

By H. L. Woodwa

Patented Feb. 20, 1934 1,947,748

UNITED STATES PATENT OFFICE

1,947,748

PAPER CLEANING MACHINE

George Van Wormer, Hamilton, Ohio

Application November 12, 1931
Serial No. 574,626

3 Claims. (Cl. 15—7)

The invention relates to cleaning machines, and particularly to a machine for cleaning paper in rolls or sheets, to remove dust and adhering particles, and for other treatments.

The machine is of special use to printers in preparing fine stock for use in presses on fine work, to reduce linting of machinery and to avoid flaws in the work such as white spots due to particles becoming interposed between paper and type or plates, dropping of ink-covered fibers or paper particles on the work, and improving the output of the presses generally.

It is an aim to present a machine adapted to be operated by inexperienced operatives in an extremely simple manner and with a minimum liability of derangement or excessive wear.

It is also a purpose to enable the construction of such a machine in a simple form and at a low cost. Another purpose is to present a novel construction in the relation and operation of the feed rolls and cleaning brushes. It is also sought to present a novel construction and arrangement in the pneumatic conveyor devices and housings.

A further purpose is to evolve a novel structure for the mounting of the rolls and brushes in the cleaning unit.

Additional objects, advantages and features of invention reside in the construction, arrangement and combination of parts involved in the embodiment of the invention, as will be understood from the following description and accompanying drawings, wherein

Figure 1 is a side elevation of the machine.

Figure 2 is a top view of the machine with parts broken away.

Figure 3 is a fragmentary longitudinal section showing a schematic view of the belting system for the brushes and feed rolls in the cleaning section, showing also the cleaning chamber in section, and pneumatic conveyor connections therewith.

Figure 4 is a cross section of the machine.

Figure 5 is a fragmentary top view of the belting system at the brushes and feed rolls of the cleaning unit.

Figure 6 is a detail of the mounting of the brushes and rolls of the cleaning chamber.

Figure 7 is a detail section of the tape boards.

There is illustrated a machine comprising a frame 10, including longitudinal side strings 11, supported by legs 12, and including such cross members 13 as desired.

At the paper-receiving end of the machine a transverse plain cylindrical roll 14 is mounted in saddle bearings 15 secured to the upper sides of the strings 11. Mounted on standards 16 at each side of the machine there is a transverse shaft a distance above the roll 14, and on this there are swingingly mounted friction rolls or wheels 17 having rubber or other suitable facings and bearing upon the roll 14 at the upper side thereof. A second feed roll 18 similar to the one 14 except that it is provided with a series of grooves is similarly mounted on the side members of the frame, located a distance inwardly of the one 14, and around the two rolls 14 and 18 a series of endless tapes 19 are extended, adapted to serve as a support for the paper fed to the machine, which paper enters between the roll 14 and the wheels 17. A tape tightening roll 20 is mounted intermediately of the rolls 14 and 18 and at a lower level in the frame 10, engaging the tapes 19. The number of tapes 19 is determined by the maximum width of the paper to be treated in the machine and the spacing of the tapes. Extending longitudinally of the machine between the rolls 14 and 18 there are tape boards 21, one under and supporting each tape adjacent the level of the tops of the rolls 14 and 18 respectively, being slightly wider than the tapes, and their outer edge portions being formed with longitudinal V-shaped ribs 22, so that the paper will be frictionally retarded in a minimum degree when it engages with the faces of the boards. Friction wheels 17 similar to those first described are mounted to bear upon the roll 18.

A cleaning chamber 25 is formed in the machine, extending transversely of the frame immediately inward of the roll 18, and including sets of rolls and brushes as will be described. Immediately beyond and to the rear of the cleaning chamber 25 a third feed roll 26 similar to the one 18 is mounted on the frame, and spaced further to the rear from the cleaning chamber there is another plain roll 27, tape boards 28 being extended between the rolls 26 and 27, and a tape tightening roll 29 is mounted below and intermediate the rolls 26 and 27. Endless tapes 30 are engaged around the rolls 26, 27 and 29. Immediately adjacent and to the rear of the roll 27 another slightly larger feed roll 31 is similarly mounted, its larger size being designed to effect more rapid movement of stock in discharge. At the delivery end of the machine a final feed roll 32 of the same size as the one 31 is mounted, a set of tapes 33 being engaged around these two rolls and an intermediate tightening roll 34. The tapes 19, 30 and 33 are in alined series. A short distance inward of the first roll 14, an upper roll 35 is mounted transversely of the machine on brackets 36 set

upon the side members 11, and a similar roll 37 is mounted just beyond the roll 31 toward the delivery end of the machine. Around these two rolls there are engaged a series of endless strands 38 of cat gut, or other suitable material, their lower reaches passing adjacent or at the level of the tapes carried on the lower rollers and their upper reaches being supported by idler rolls 39. Suitably located friction rolls 17 may be mounted in engagement with the rolls 26 and 31.

The rolls 14, 18, 26, 27, 31 and 32 are all shorter than the distance between the side members 11 of the frame 10, and rolls 27 and 31 have grooved pulleys 40 thereon at one side of the frame by which they are belted together by round belt 41. The rolls 14 and 27 have sprocket wheels 42 thereon receiving chains 43 from sprockets 44 on counter shafts 45 in the lower part of the frame, these being driven from the motor 46.

A longitudinally arranged series of pedestals 47 are mounted on the upper edges of the side members 11, and in each there is revolubly mounted a vertical screw 48 having right hand threads at the lower part and left hand threads on the upper part, a hand wheel being provided at the top of each screw.

The pedestals have vertical guide-ways at their inner sides in which there are slidable bearing blocks 49 provided at their inner sides with step bearings 50 receiving respective shafts 51 of brush or feed rolls to be described. The blocks are threaded through their outer parts to receive the screws 48, there being one block on the upper part of each screw, and one on the lower part of each screw. By rotation of any screw 48 the blocks 49 thereon may be drawn together or separated, as required, both moving commonly from or toward an intermediate level. The outer sides of the pedestals are vertically slotted a distance, and each block has engaged in its outer side a hand set screw 52 extending through the outer slot of the pedestal and having a hand wheel thereon.

Seven pedestals are shown at each side of the machine, and in these are alternated feed rolls 53 and rotary cleaning brushes 54, each pedestal carrying two rolls or brushes of similar function, coacting on an interposed sheet when the machine is in use. There are four rolls and three brushes in each horizontal series, the brushes and rolls alternating. Mounted suitably in the bearing blocks of the brushes there are clearing rods 55 arranged to be engaged by the extremities of the bristles of the respective brushes so that dirt gathered thereon will be dislodged in rotation of the brush. The rods are over the upper brushes, and under the lower ones. The brushes are of slightly greater diameter than the diameter of the rolls 53, although this is not material as the brushes can always be adjusted independently for proper action on the paper to be cleaned. The bristles are preferably good hog bristles, a fairly heavy Siberian bristle of three-quarters of an inch length having been used with good effect, although it may be found desirable to vary the stiffness or use other materials to suit different kinds of materials cleaned. A substantial portion of the shafts 51 of all the brushes and rolls are exposed at the right hand side of the machine which is the side shown in Figure 1, and on these shaft ends there are provided grooved pulleys 60 in sufficient number to enable belting of the rolls and brushes as at 61 to rotate as desired. For this drive, two round belts 56—57 are shown running from suitable pulleys 58 on the counter shaft 45. Belt 56 is crossed between the counter shaft in order to enable operation of the upper set of brushes and rolls and the lower set in opposite directions so that their peripheries move in the same direction next the path of paper being cleaned. Idler pulleys 59 are mounted below the cleaner chamber, a little in advance of a direct line between the counter shaft 45 and the first rolls of the cleaning chamber. The counter shaft rotates clockwise as viewed from the right, which is the same as the direction of all the lower rolls and brushes in the machine. In order to effect better efficiency in the drive, the belt 56 is run from the top of its drive pulley 58 to the front side of the first upper brush pulley from below thence upward and rearwardly over this pulley to the last upper brush pulley, thence down and forwardly over a pulley 59, and thence to the drive pulley 58 again. The belt 57 is run from the bottom of the drive pulley 58 to the first lower brush pulley, thence to the rear lower brush and forward and downward around the idler 59 back to the drive pulley. The brushes and rolls are interconnected by short belts 61 in the upper and lower series so that all upper brushes and rolls turn counter clockwise and the lower series clockwise.

That is to say, the first and the last brush pulley 60 in each series is connected to the pulleys 60 on the next adjacent feed rolls by respective short belts 61 passing around only the two mutually adjacent pulleys, while the central brush pulley 60 is connected by a similar belt 61 to a pulley 60 on the shaft of the next adjacent feed roll. On the shaft 51 of the first and last brushes in each series, therefore, there are three pulleys 60 in each instance, one to receive the belt 56 or 57 as the case may be, and two for the respective belts 61 to next adjacent feed rolls, while one of the inner feed rolls in each series has two pulleys 60, one by which it is belted to the outer brush, and the other by which it is belted to the inner brush. The other feed rolls and the central brush have but one pulley 60 on their respective shafts. In this way, removal of any of the brushes or rolls from its series will involve the removal of only simple short belts, all easily accessible immediately at the pulleys, except in the case of one of the outer brushes where a simple loop of the belt 56 or 57 is to be manipulated. The replacements of the belts in no instance require twisting or peculiar tortuous arrangement, so that there is a minimum liability of incorrect replacement.

The enclosure of the cleaning chamber consists of the bottom pan 65, having an air inlet port 66 at the left hand side, opening through the bottom 67 of this pan. The bottom is apertured to pass the belts 56 and 57 with a moderate clearance. The ends of the pan have upward extensions 68 close beside the bearing blocks 49, and front and rear side walls 69 are extended upwardly between the rolls 18 and 53, and 26 and 53 respectively. These walls have outwardly turned edges or lips 70 which may rest against or lie close to the gut strings 38 and 77 supporting the paper as it enters the cleaning chamber. The top section of the cleaning chamber comprises a hood 71 mounted and constructed with end and side walls to aline with those of the bottom pan, its end walls being slotted to receive the shafts of the rolls and brushes 53—54.

The gut-strings 38 pass over the hood, and are located at close intervals for some work. The hood has a top wall 72 through which there open a multiplicity of small flues 73, which may be ovate in cross section with the major axis

of the oval extending longitudinally of the machine. These flues are located at intervals of about four inches as heretofore practiced. The flues 73 lead through the bottom wall of a manifold T 74, from the upper side of which there leads a flue 75, in which a suction fan 76 may be located at a suitable point.

A number of endless gut strings 77 may also be engaged around the two rollers 18 and 26, and idler pulleys or rolls 18' and 26' below, the upper reaches of these guts extending through the cleaning chamber to support the lower side of paper passing therethrough. It may be found desirable in some cases to omit these strings, as the suction in the upper part of the cleaning chamber will tend to draw the paper upward against the gut strings 38 which will hold it in proper alinement.

Guide bars 78 are mounted at each side of the machine as required, arranged to engage the edges of sheets passing through the machine, to hold them properly in line with the rolls and brushes.

In the chamber 25 there are mounted manifold high pressure air pipes 79 running fore and aft or parallel to the path of the paper, there being four of these pipes, two being located at near each end of the chamber above and below the brushes 54. On these pipes are mounted jet nozzles 80 to discharge air from the pipes and projected toward the plane or path of paper passing through the machine. The ends of these nozzles are turned so as to direct air toward the paper and between the brushes and rolls at such inclination as to lift particles away from the paper at the upper side, and move such particles downwardly from the lower side of the paper, so that they may be carried readily to the flue 75 by the draft drawn outward by the fan 76. Air may be supplied to the pipes 79 by any suitable compressor device, not shown.

At the rear end of the machine, upper tape wheels 81 are mounted over the last roll 32, and tapes 82 may be extended from these wheels and the rolls 32 to any desired point where a "laboy" or other stacking or receiving device may be located.

In use, the motor 46 and fan 76 being in operation and the air jets 80 operated, paper is supplied to the cleaning machine by hand or machine by being entered between the roll 14 and the wheels 17. From there it quickly passes through the opening between hood and pan to the roll 35 whence it is carried between the tapes 19 and gut strings 38 to the cleaning chamber 25. Here it becomes engaged between the first two rolls 53 and is quickly passed between the brushes and succeeding rolls until it passes out of the cleaning chamber between the hood and bottom pan to the rolls 26 and tapes 30. The operation of the fan 76 draws air rapidly inward through the inlet port 66, while the jets 80 project air toward the paper between the brushes and rolls.

When a sheet is engaged entirely across the chamber 25, the air passes toward the right hand side of the machine, where it moves upwardly between the shafts 51 and to the flues 73 to the manifold 74 and conduit flue 75. The brushes quickly loosen any dust and dirt or loose particles on the paper, and the air passing through the chamber as described carries such matter with it, through flue 75, as will be readily appreciated.

I claim:

1. A paper cleaning machine comprising a casing, means to move thin paper web into, across and out of the casing including substantially continuous paper supporting means above and below the path of the paper in the casing, paper brushing devices therein arranged and including exceedingly attenuated and flexible paper surface engaging members to engage a moving sheet in the casing, means to exhaust air from the casing, and air inlet means to admit air to the casing in such location that an air current will be formed across the surface of paper moving through the machine, whereby the air current will entrain the detritus without passing through the web materially.

2. A paper cleaning machine comprising a casing, means to move thin paper web into, across and out of the casing, paper brushing devices therein arranged to engage a moving sheet in the casing, means to exhaust air from the casing and air inlet means to admit air to the casing whereby the air currents will entrain the detritus, said means to move the paper including means to move the paper through the case with one edge close to a side of the case and the opposite edge spaced from the opposite side of the case, the said inlet means being close to said first named side of the case and at the opposite side of the paper from the exhaust.

3. A paper cleaning machine comprising a cleaning chamber, a multiplicity of upper and lower opposed sets of feed rolls adapted to co-engage upon and feed paper between the sets, and alternated rotary brushes arranged to engage the paper between the rolls, means to rotate the rolls, and means to rotate the brushes in the same direction with the adjacent rolls at a higher speed, said rolls and brushes including mounting shafts projecting a materially greater distance at one end than at the other, the chamber having an end wall close to the brushes and rolls, and an opposite wall spaced a material distance from them, whereby to form a wide space for passage of air, said chamber having a bottom spaced below the rolls and brushes and having an air inlet port near the first named wall of the chamber, said chamber having an air outlet in its upper part and means to exhaust air through the outlet.

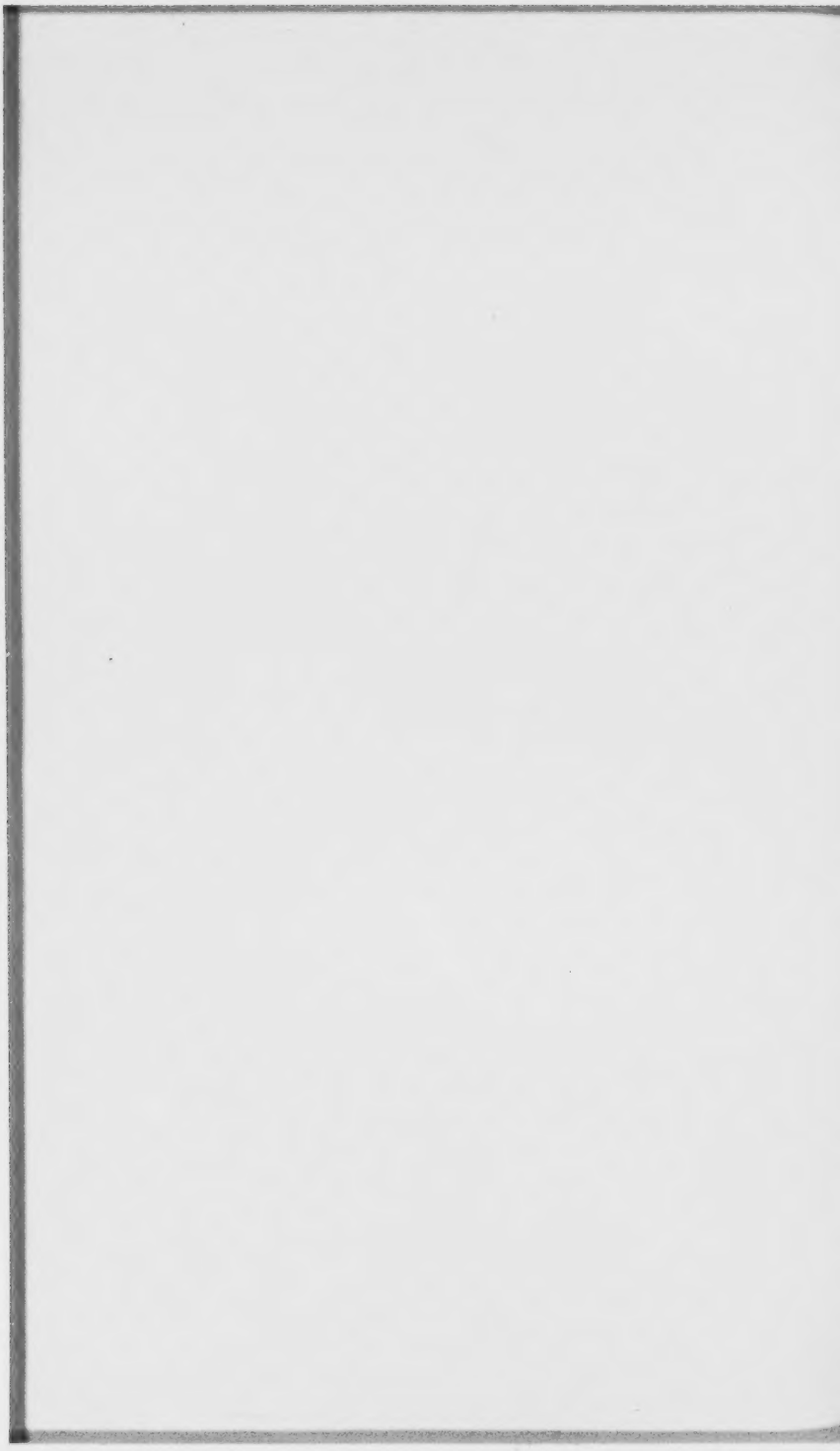
GEO. VAN WORMER.

DISCLAIMER

1,947,748.—*George Van Wormer*, Hamilton, Ohio. PAPER CLEANING MACHINE. Patent dated February 20, 1934. Disclaimer filed September 26, 1938, by the patentee.

Hereby enters this disclaimer to the part of claim 1 and claim 2 that relates to the paper brushing devices arranged to engage a moving sheet, except where the brushes are made of a fairly heavy hog bristle and are arranged to rotate in the direction in which the sheet is moving; and that part of claim 3 that relates to rotary brushes except where they are made of a fairly heavy hog bristle.

[*Official Gazette October 18, 1938.*]



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IN THE

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Petitioner,

v.

THE CHAMPION PAPER & FIBRE COMPANY,

Respondent.

PETITION FOR REHEARING OF PETITION FOR WRIT OF CERTIORARI

WALTER F. MURRAY,
Counsel for Petitioner.

THE JOHNSON & HARDIN CO., LAW PRINTERS
CINCINNATI, OHIO

IN THE

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OCTOBER TERM, 1942

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THE CHAMPION PAPER & FIBRE COMPANY,

Respondent.

PETITION FOR REHEARING OF PETITION FOR WRIT OF CERTIORARI

To the Honorable the Chief Justice and Associate Justices of the Supreme Court of the United States:

Your petitioner respectfully requests a reconsideration of its Petition for Writ of Certiorari that was denied upon December 7, 1942. Your petitioner's case is quite distinct from the case of *Hailes* v. *Albany Stove Co.*, 123 U. S. 582, 587, to which prominence is given in *Milcor Steel Co.* v. *George A. Fuller Co., et al.*, 316 U. S. 142, 147, 148. In

Hailes v. *Albany Stove Company,* the disclaimer was as follows:

> "Your petitioners, therefore, hereby enter their disclaimer to so much of the first claim as covers perforations or openings in the sides of a suspended firepot extending throughout the entire depth of sides, and limiting such perforations or openings to substantially the lower half of the firepot, the material or substantial part of the thing patented in and by said claim not hereby disclaimed being as follows:
>
> > 'A firepot suspended from its upper edge with substantially the upper part of its sides made solid, and substantially the lower half of its sides containing perforations or openings.' "

Of this the Court said:

> "This is what has been attempted in this case. There is no word, or hint, in the patent, that the invention claimed was a firepot with sides grated only half-way, or part of the way from the bottom towards the top, or that partially grated sides have any advantage over those grated all the way to the top. The first claim, as modified by the disclaimer, has nothing in the specification to stand upon, nothing to explain it, nothing to furnish a reason for it."

The facts in this case are quite distinct from the facts in your petitioner's case. This is shown by what the Court of Appeals said about your petitioner's specification, viz:

> "Moreover, we think that appellee's contention that the disclaimer introduced a new element into the claim and hence invalidates it must be sustained. The limitation in the disclaimer to the use of a brush composed of hog bristles does not extend the claim. It originally specified paper brushing devices, and such devices might be either of camel's hair or bristles, or of any proper brush material. However, the claim as originally written does not include the rotation of the brushes. It is quite conceivable that under the broad

> phrase 'paper brushing devices therein arranged' the brushes might be vibrated instead of rotated. Appellee urges, and it is true, that the specifications described rotation of the brushes, but that does not save the claim which is so broadly drawn as not to include this element." 129 Fed. Rep. 2(d), 428-430.

Your petitioner's case therefore is distinct from *Hailes* v. *Albany Stove Co.*, in that the limitation placed on the claim by the disclaimer was described in your petitioner's specification, and was not described in the specification in *Hailes* v. *Albany Stove Company.*

In *Milcor Steel* v. *George A. Fuller Co.*, supra, after referring to *Hailes* v. *Albany Stove Co.*, this Court says:

> "If an alteration of one of the essential elements of a claimed combination were permissible at all it would be under the reissue statute, Rev. Stat. § 4916, 35 U. S. C. § 64, which grants rights only from the date of reissue and after consideration of the patent office."

However, it is submitted that your petitioner's patent was subject to the right of disclaimer because the part which the patentee disclaimed, viz: brushing devices other than the brushes rotating in the direction of the paper, was distinguishable on the face of the specification. The correction therefore was one that need not be made by reissue. *Grasselli Chemical Company* v. *National Aniline & Chemical Co.*, 26 Fed. (2d) 305-310 (C. C. A. 2nd).

Your petitioner's case is further distinct from *Milcor Steel* v. *George A. Fuller Co.*, in which this Court said:

> "Limiting ourselves as we must to the original claims to determine the nature of the combination covered by the patent when it was granted, and comparing that combination with the one purportedly embodied by the claims after the disclaimer, we can only conclude that the revised patent *includes new elements* which were not present in the original." (Italics ours.)

The Court then in *Milcor* v. *Fuller,* supra, analyzes *Altoona* v. *Tri-Ergon Corp.,* 294 U. S. 477, and says that the Court: "concluded that the disclaimer statute 'does not permit the *addition of a new element* to the combination previously claimed whereby the patent originally for one combination is transformed into a new and different one for the new combination.' "

In both *Milcor* v. *Fuller* and *Altoona* v. *Tri-Ergon Corp.,* supra, this Court held the disclaimers invalid on the ground that they added new elements which were not present in the combination originally claimed. However, in both of these cases the original claims did include "the element" in broad terms, and the disclaimers purported to include this "element" in a specific form, namely, a "fly-wheel" in one of the cases and an "angle iron" in the other case. In your petitioner's case the Court referred to something intangible, viz: *rotation* of the brushes as an "*element*" not present in the original claim.

It is submitted that the characterization of the change of an element of a combination from general terms to specific terms as an addition of an element has no precedent in the Patent Law, and that this has led the Court in the instant case to characterize *rotation* of brushes as an element. See *Pickering* v. *McCullough,* 104 U. S. 310-318, for definition of "an element" of a combination. It is submitted that this shows that there is need for clarification of what is meant by the addition of an element to a combination as used in *Altoona Publix Theatres* v. *American Tri-Ergon,* and *Milcor Steel* v. *George A. Fuller,* supra.

Respectfully submitted,

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